

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicant : William J. Baer et al.
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Examiner : Basehoar, Adam L
Customer No. : 46157
Docket No. : STL920000020US1 (0920.0041C)
Title : Method and System for Calculating Cost of a Compilation
of Content

Commissioner for Patents
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REPLY BRIEF

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Commissioner for Patents
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Sir:

This reply brief is presented in response to the Examiner's Answer mailed January 6, 2011.

The brief is filed pursuant to the requirements of 37 C.F.R. §41.41.

(1) Status of Claims

Claims 1 - 24 are currently rejected under 35 U.S.C. §103(a) and are on appeal.

Claims 25 - 27 have been canceled.

(2) Grounds of Rejection to be Reviewed on Appeal

(A) Whether claims 1 - 2, 7 - 10, 15 - 18, and 23 - 24 are unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 6,147,768 (Norris) in view of U.S. Patent No. 6,072,479 (Ogawa).

(B) Whether claims 3 - 6, 11 - 14, and 19 - 22 are unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 6,147,768 (Norris) in view of U.S. Patent No. 6,072,479 (Ogawa), in further view of U.S. Patent No. 5,768,521 (Dedrick).

(3) Argument

(A) Rejection of Claims 1 - 2, 7 - 10, 15 - 18, and 23 - 24 under 35 U.S.C. §103(a) as Being Unpatentable Over the Combination of the Norris and Ogawa Patents

In the Office Action of April 1, 2010, and the Examiner's Answer of January 6, 2011, the Examiner has rejected claims 1 - 2, 7 - 10, 15 - 18, and 23 - 24 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,147,768 (Norris) in view of U.S. Patent No. 6,072,479 (Ogawa).

Briefly, the Examiner has determined that the differences between the Norris patent and the claims at issue consist of the following features (as stated at Page 4 of the Office Action of April 1, 2010, and Pages 5 - 6 of the Examiner's Answer of January 6, 2011).

"Norris **does not specifically teach** generating an estimated content count for the selected content entities that represents an estimated quantity of content within the content object, wherein the digital data within the selected content entities are utilized to determine the estimated content count representing the estimated quantity of content within the content object, and generating from the estimated content count the estimated price to serve as the price for the user to produce the user-defined content object with the selected content entities in response to said parameter setting indicating the estimated price, wherein the estimated price is determined based on a price per unit of content, and wherein the unit of content represents a predetermined quantity of content and the estimated content count indicates an estimated quantity of said units of content for the selected content entities."

In order to compensate for the admitted deficiencies of the Norris patent, the Examiner further alleges that the Ogawa patent discloses the above claimed features lacking in the Norris patent (as stated at Pages 4 - 5 of the Office Action of April 1, 2010, and Page 6 of the Examiner's Answer of January 6, 2011).

Ogawa teaches generating an estimated content count for the selected content entities that

represents an estimated quantity of content within the content object, wherein the digital data within the selected content entities are utilized to determine the estimated content count representing the estimated quantity of content within the content object, and generating from the estimated content count the estimated price to serve as the price for the user to produce the user-defined content object with the selected content entities in response to said parameter setting indicating the estimated price, wherein the estimated price is determined based on a price per unit of content, and wherein the unit of content represents a predetermined quantity of content and the estimated content count indicates an estimated quantity of said units of content for the selected content entities."

However, since the Ogawa patent does not disclose, teach, or suggest the above claimed features lacking in the Norris patent as discussed below and in the Appeal Brief, the combination of the Norris and Ogawa patents relied upon by the Examiner does not disclose, teach, suggest, or render obvious each and every feature within the independent claims.

(A.1) Claim Construction

In order to sustain the rejection despite the glaring deficiencies of the Norris and Ogawa patents noted in the Appeal Brief, the Examiner provides various interpretations of the claims, even to the point of ignoring expressly recited claim limitations. However, each of these interpretations is incorrect and/or impermissible as discussed below.

In particular, the Examiner takes the position that the claims do not recite the features upon which Appellants rely, nor a specific calculation as exemplified in Appellants' specification (e.g., See Examiner's Answer Pages 11 - 12). Further, the Examiner asserts that the claims lack a clear distinction on specifically how the total estimated price for the user defined content object is generated from the estimated content count (e.g., See Examiner's Answer Page 16).

However, it is respectfully submitted that the claims do positively and clearly recite these features. In particular, independent claims 1, 9, and 17 each recite: "generating an estimated content

count for the selected content entities"; "the digital data within the selected content entities are utilized to determine the estimated content count"; "the estimated content count indicates an estimated quantity of said units of content for the selected content entities"; "the unit of content represents a predetermined quantity of content"; "generating from the estimated content count the estimated price"; and "the estimated price is determined based on a price per unit of content."

Thus, the claims clearly recite that the estimated price is determined from the estimated content count (the estimated quantity of units of content (the unit of content refers to a predetermined amount of content)) and the price per unit of content. The digital data within the content entities are utilized to determine the estimated content count (or quantity of units of content). Dependent claims 3 - 4, 6, 11 - 12, 14, 19 - 20, and 22 further elaborate on these features and recite determining a character count for the entity, determining a page count from the character count, and multiplying the page count with a predetermined price per page value.

For example, a present invention embodiment may enable selection of various content sections for a book. An estimated price may be determined based on an estimated quantity of pages within the selected content sections, and the price for each page. The estimated pages may be determined by the number of characters within the selected content sections (determined by utilization of the content within the selected content sections) divided by an average number of characters per page.

The Examiner takes the additional position that the claim language of the independent claims generates a price for the content object in the alternative form. In other words, the Examiner indicates that the claims do not require generating both an actual price and an estimated price, but

rather only require generating one or the other based on some parameter setting (e.g., See Examiner's Answer Page 17). The Examiner further asserts based on this claim construction that the estimated price features are optional and, therefore, do not limit the claim scope. Thus, according to the Examiner, the Norris patent teaching creation of an actual price for the content entity, discloses the claimed invention.

Initially, the Examiner merely relies on Appellant's arguments to support this claim construction (e.g., a statement in the Appeal Brief indicating that optionally actual costs may be utilized to produce the book's costs (e.g., See Examiner's Answer Page 17)).

However, the statement in the Appeal Brief is provided in the context of an example for generating a book and the corresponding estimated price for that book in order to explain the estimated pricing features for distinguishing over the cited art. Thus, the statement relied upon by the Examiner merely supplements the description of the estimated pricing, and demonstrates the ability to produce an estimated price and an actual price for the book.

Further, the specific elements for generating the estimated price are positively (not optionally) recited in the independent claims. In particular, the independent claims recite a parameter setting utilized to control operation of the claimed invention (e.g., "generating from the estimated content count the estimated price to serve as the price for the user to produce the user-defined content object with the selected content entities in response to said parameter setting indicating the estimated price"), and additional claim elements for generating the estimated price (e.g., a computer, program instructions, or means that generates an estimated content count; a computer, program instructions or means that generates from the estimated content count the

estimated price; etc.).

Thus, the Norris system, which only generates an actual price, does not include these positively recited claim elements for generating the estimated price. In other words, even assuming a device of the claimed invention operated to produce an actual price, this device still operates in the claimed manner based on the parameter setting and contains the positively recited structural claim elements to generate the estimated price (e.g., a parameter setting utilized to control operation; a computer, program instructions, or means for generating an estimated content count; a computer, program instructions or means for generating from the estimated content count the estimated price; etc.), all of which are missing from the Norris system (and other systems with only an actual price).

The language utilized by the Examiner in the Examiner's Answer (e.g., Examiner's Answer Page 18, "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation") is **substantially identical** to the language within M.P.E.P. §2106(II)(C) and §2111.04. These sections and the materials therein have, in effect, been cited by the Examiner due to the language within the Examiner's Answer, and are not first presented by Appellants. In addition, since this position was not presented by the Examiner in the Final Office Action of April 1, 2010, the arguments below could not have been presented earlier in the Appeal.

The above sections of the M.P.E.P. raised by the Examiner provide non-exhaustive examples of suggestive or optional claim language (e.g., whereby, etc.) that may raise an issue with respect to their limiting effect in a claim. The Examiner considers the estimated pricing features of the independent claims to be of the same type and have the same limiting effect on claim scope as the

language referred to in those sections of the M.P.E.P. Thus, the Examiner considers the estimated pricing features to be optional claim limitations that have no effect on claim scope.

However, M.P.E.P. §2111.04 further indicates that when this type of claim language states a condition that is material to patentability, the language cannot be ignored in order to change the substance of the invention (citing Hoffer v. Microsoft Corp., 74 U.S.P.Q.2d 1481, 1483 (Fed. Cir. 2005)). The court in Hoffer further indicated that this type of claim language limits the scope of the claim when the language provides more than an intended result of a process step, and is part of the process itself. Hoffer, 74 U.S.P.Q.2d at 1483 - 1484.

In this case, the estimated pricing features of the independent claims are clearly material to patentability. In particular, the estimated pricing features have been argued as distinguishing features during prosecution and on Appeal. Further, the current rejection itself indicates the materiality of the estimated pricing features. In the rejection, the Examiner has conceded that the estimated pricing features distinguish the independent claims over the Norris patent, and provided a secondary reference in order to allegedly account for those features as discussed above.

Moreover, the independent claims positively recite specific elements for generating the estimated price as discussed above (e.g., a parameter setting utilized to control operation of the claimed invention; a computer, program instructions, or means that generates an estimated content count; a computer, program instructions or means that generates from the estimated content count the estimated price; etc.). The parameter setting and additional claim elements are positively recited components that form part of the claimed invention itself. Accordingly, since the estimated pricing features of the independent claims are clearly material to patentability and form part of the claimed

invention as discussed above, these features affect claim scope and cannot be ignored.

In view of the foregoing, the estimated pricing features are positively recited elements that affect claim scope and, therefore, the construction ignoring these features as proposed by the Examiner is improper.

(A.2) The Ogawa Patent

The Examiner takes the position that the Ogawa patent compensates for the above-discussed deficiencies of the Norris patent, and specifically teaches: (1) a multimedia application that could include a plurality of surrogate media objects, wherein **the surrogate media objects represented the actual media object to be created later** for the multimedia application, and wherein the surrogate media objects included for example, voice objects, image objects, and moving picture objects; (2) surrogate media objects necessary for creating the multimedia application were collected in a list which was utilized for calculating the estimated/size content and/or cost for each type of media object as well as the total estimated size count and/or cost for the multimedia application; (3) a calculation module that calculated the estimated content count/size for each of the media types **based on media dependent attributes and on predefined formulas** that factored in the amount of digital data within the surrogate media objects; and (4) the estimated content count for each media type was then added together to get a total estimated content count for the multimedia application (e.g., See Examiner's Answer Pages 13 - 14).

However, the Ogawa patent discloses a scenario editing system which helps create multimedia applications **beginning in the planning and design stage (scenario creation stage)**

(e.g., See Column 1, lines 7 - 11). The Ogawa patent explains that the process for creating multimedia application products usually includes: writing a multimedia project chart or story rough sketch (scenario) called a storyboard, creating voice or video objects as actual media objects based on the scenario; and assembling the media objects with the use of an authoring tool (e.g., See Column 1, lines 14 - 23).

The Ogawa patent further discloses that it is important **to estimate the size of data during multimedia application development**, and that it is necessary **to estimate the application size before starting media creation** in order to lower development cost (e.g., See Column 2, lines 43 - 50). In order to perform these estimation functions, embodiments of the Ogawa patent employ surrogate media objects that serve as placeholders for actual media objects in order **to perform data size and cost estimates at the scenario creation stage** (e.g., prior to completion of the actual media objects) (e.g., See Column 1, lines 50 - 51 (Prior art 2 referenced by the first embodiment, Column 6, line 50); Column 3, lines 24 - 28; Column 5, lines 40 - 43 and 47 - 51; and Column 6, lines 53 - 56).

The user can create a slot in a scene (for surrogate media objects) to specify a media type or size, or draw graphics (sketch) to describe the contents, **even when actual media objects are not available**. In addition, the user can bind an existing media object to a slot as a **temporary** surrogate media object to serve as a dummy object for the media object to be created later. The use of sketches or existing media objects as a surrogate media object provides editing advantages (e.g., See Column 6, lines 53 - 67). The surrogate media object is used to describe the detail about sketch information to be drawn in a slot and about a media object to be bound. This object is generated when a new slot object is generated (e.g., See Column 8, lines 18 - 20).

A sketch input module displays a scene editing screen to allow a user to enter a sketch, or to bind a media object (**which is used temporarily**) to a slot (e.g., See Column 9, lines 35 - 37). A scene management module contains created scene and slot objects (e.g., See Column 10, lines 15 - 16), while a surrogate media management module contains the surrogate media objects created by the sketch input module (e.g., See Column 10, lines 29 - 30). A surrogate media list module creates thumbnails of the surrogate media objects recorded in the surrogate media management module, and displays the thumbnails (e.g., See Column 10, lines 33 - 35).

When a user clicks on a thumbnail (of a surrogate media object), a dialog box is displayed in which **default values for various attributes of the surrogate media object** are displayed and may be changed by the user (e.g., See Column 11, lines 13 - 40).

A calculation module **reads media attribute information** from the surrogate media management module, **reads surrogate media objects**, one at a time, checks the media type attribute, and uses specific formulas for each media type to determine the size of that surrogate media object. The sizes for each media type are summed to determine the application size (e.g., See Column 11, line 45 to Column 12, line 14).

As discussed above, the Examiner construes the data sizes determined by the calculation module to read on the claimed features of generating an estimated content count for the selected content entities, wherein the digital data within the selected content entities are utilized to determine the estimated content count, wherein the estimated content count indicates an estimated quantity of said units of content for the selected content entities, and wherein the unit of content represents a predetermined quantity of content. In addition, the Examiner takes the further position that the

independent claims do not preclude the formulas of the Ogawa patent for calculating the size of surrogate media objects, and that these calculations of sizes include calculating based on the number of bits of data within the voice, still picture, and movie picture digital objects (e.g., See Examiner's Answer Pages 14 - 15).

However, the formulas of the Ogawa patent relied upon by the Examiner **determine a total size for the media object from default values or values entered by a user for object characteristics** (e.g., that relate to presentation mechanisms, such as channels, display size, frame rate, compression ratio), rather than providing an estimated quantity of content units (with each content unit including a predetermined amount of content) by utilizing the actual digital data within the objects as recited in the independent claims.

Specifically, with respect to voice data, the size is determined from the number of channels, the number of bits (per channel), the sampling rate and the compression ratio (e.g., compare the formula at Column 11, lines 56 - 62 with the attributes within the Table at Column 11, lines 25 - 40). The size of still picture data is determined from the screen display size, the number of bits (based on the quantity of colors used) and the compression ratio (e.g., compare the formula at Column 12, lines 1 - 4 with the attributes within the Table at Column 11, lines 25 - 40). The size of moving picture data is determined from the screen display size, the number of bits (based on the quantity of colors used), the frame rate, and the compression ratio (e.g., compare the formula at Column 12, lines 11 - 14 with the attributes within the Table at Column 11, lines 25 - 40).

In fact, the Ogawa patent needs to rely on the attributes to determine size **since the estimates are being performed during the media object creation stage, and the actual media objects for**

which the surrogate media objects hold a place may not yet exist or may be incomplete as discussed above.

Although the Ogawa patent briefly mentions completed surrogate media objects, the sizes for these objects are still determined by the above attribute-based formulas (e.g. See Column 18, lines 1 - 4). In addition, these completed surrogate media objects are merely utilized for comparison with incomplete objects to determine the progress of application development (e.g., See Column 17, lines 19 - 20 and 41 - 42; and Column 17, line 66 to Column 18, line 4).

The Examiner takes the further position the Ogawa patent discloses that: (1) the estimated price for generating the application was directly related to the size of the surrogate media objects, and notes that the concept of relating an amount of information/product to be purchased to its cost is well known in the commerce art (e.g., See Examiner's Answer Page 14); and (2) when calculating the estimated price for a surrogate media object, the price was determined based on a price per unit of content as set by the user (e.g., See Examiner's Answer Page 15).

However, the development cost of the Ogawa patent is determined with development time as the base (e.g., See Column 13, lines 48 - 50). In particular, the formulas provided by the Ogawa patent calculate the cost as the product of development time (hours) and cost per hour (e.g., See Column 13, lines 59 - 62; and Column 14, lines 1 - 3 and 10 - 12). This and other information (e.g., name of person in charge, scheduled development time, development start date, development end date, cost per hour) are provided by the user (e.g., See Column 13, lines 40 - 45). Thus, there is no disclosure in the Ogawa patent of a cost per unit of content being entered by the user, nor utilization of the size determination to calculate this cost as alleged by the Examiner.

The Ogawa patent simply determines development cost based on the quantity of labor hours and the cost for each hour, which are distinctly different than an estimated quantity of content and cost per unit of content as recited in the independent claims. In fact, the hourly labor rate (fixed) and the development time are both determined and entered by the user (e.g., See Column 13, lines 40 - 45, and 61; and Column 14, lines 3 and 12).

The Examiner notes that the concept of relating an amount of information/product to be purchased to its cost is well known in the commerce art (e.g., See Examiner's Answer Page 14). This position seems to imply that the development cost of Ogawa (e.g., hours and rate provided by the user) is proportional to the size of the object. However, the Ogawa patent does not disclose, teach, or suggest such a relationship, nor provide an indication of the manner in which the user determines the hours and labor rate for the development cost. In fact, the Ogawa patent discloses that one editing advantage to using an existing media object as a surrogate media object is to create a new picture from an already-created picture (e.g., See Column 6, lines 61 - 64). In this case, the time (and cost) to develop a new picture of greater size from an already-created picture may be less than the time (and cost) required to create a smaller sized picture from scratch. Thus, the projected cost in the Ogawa patent depends on the work (or time) involved to create and develop the surrogate media object as determined by the user. This clearly teaches away from the relationship alleged by the Examiner, and nullifies any proposed combination with the Ogawa patent even if this relationship is well known in the art.

In addition, since the start and end development dates are provided by the user, the estimated cost is clearly a projected cost (based on an hourly labor rate and the amount of time) **to create and**

develop the surrogate media object (which does not yet exist). Thus, the projected cost cannot be based on an estimated content count determined from actual content of the surrogate media object if this object has not yet been developed. Accordingly, there is no disclosure, teaching or suggestion of the estimated price being based on the price for a unit of content and the estimated quantity of those units (determined from the actual content of the objects) within the content object as recited in the independent claims.

Thus, the features lacking in the Norris patent are not disclosed, taught or suggested by the Ogawa patent and, therefore, the combination of these patents relied upon by the Examiner fails to disclose, teach, suggest or render obvious each and every feature recited in the independent claims.

Since the proposed combination of the Norris and Ogawa patents does not disclose, teach, suggest or render obvious the features recited in independent claims 1, 9, and 17 as discussed above and in the Appeal Brief, the rejection is considered improper.

Claims 2, 7 - 8, 10, 15 - 16, 18, and 23 - 24 depend, either directly or indirectly, from independent claims 1, 9 or 17 and, therefore, include all the limitations of their parent claims. These claims are considered to overcome the combination of the Norris and Ogawa patents for substantially the same reasons discussed above and provided in the Appeal Brief.

(B) Rejection of Claims 3 - 6, 11 - 14, and 19 - 22 Under 35 U.S.C. §103(a) as Being Unpatentable Over the Combination of the Norris, Ogawa, and Dedrick Patents

In the Office Action of April 1, 2010, and the Examiner's Answer of January 6, 2011, the Examiner has rejected claims 3 - 6, 11 - 14, and 19 - 22 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,147,768 (Norris) in view of U.S. Patent No. 6,072,479 (Ogawa),

in further view of U.S. Patent No. 5,768,521 (Dedrick).

Initially, claims 3 - 6, 11 - 14, and 19 - 22 depend, either directly or indirectly, from independent claims 1, 9 or 17 and, therefore include all the limitations of their parent claims. These claims are considered to overcome the combination of the Norris and Ogawa patents for substantially the same reasons discussed above and provided in the Appeal Brief.

The Examiner takes the position in the Examiner's Answer that the Dedrick patent discloses calculating an estimated price based on a price per unit of content, wherein the content within the content entities is measured in a predetermined quantity of bytes, wherein the unit of content represents a predetermined quantity of content, and the estimated content count indicates an estimated quantity of units of content for the desired/requested content entities (e.g., See Examiner's Answer Pages 16 - 17).

The Examiner now appears to be combining the Dedrick patent with the Norris and Ogawa patents to address features recited within the independent claims. However, the Dedrick patent does not disclose, teach or suggest the claimed features lacking in the combination of the Norris and Ogawa patents discussed above.

As discussed in the Appeal Brief, the Dedrick patent discloses a computer network system that contains a metering mechanism which can meter the flow of electronic information to a client computer within a network (e.g., See Abstract; Column 1, lines 62 - 65; and Column 2, lines 43 - 64). The client computers each contain a graphical user interface to request consumption of the information (e.g., See Abstract; Column 2, lines 2 - 4; and Column 3, lines 13 - 30). The metering mechanisms control the transfer of information to the client computers (e.g., See Abstract; Column

2, lines 4 - 6; and Column 3, lines 46 - 59).

Although each unit of information has an associated cost type and cost value that are used to calculate a price for the information (e.g., See Abstract; Column 2, lines 7 - 10; and Column 3, lines 60 - 63), there is simply no disclosure, teaching or suggestion of estimating the content within the information requested for transference to a client computer. The Dedrick patent merely meters flow of electronic information to a client computer, and may determine a price for the electronic information based on the quantity of information being metered and transferred (e.g., the meter determines the amount of information to be transferred). Thus, the Dedrick patent does not disclose, teach or suggest estimating the content within the information requested or, for that matter, an estimated price being determined based on a price per unit of content, wherein the unit of content represents a predetermined quantity of content and the estimated content count indicates an estimated quantity of units of content for the selected content entities as recited in the claims.

Since the combination of the Norris, Ogawa, and Dedrick patents relied upon by the Examiner does not disclose, teach, suggest or render obvious the features recited in claims 3 - 6, 11 - 14, and 19 - 22 as discussed above and in the Appeal Brief, the rejection is considered improper.

(4) Conclusion

In view of the foregoing and the reasons indicated in the Appeal Brief, it is submitted that the rejections of claims 1 - 24 are improper and, accordingly, the Board is respectfully requested to reverse the rejections and order that this application be allowed.

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